

REMARKS

Presently pending in this application are claims 1-32. In the office action mailed December 4, 2003, the Examiner rejected claims 23-26 and 31-32 under 35 U.S.C. §102(e) as being anticipated by Fijolek (U.S. Patent No. 6,240,464 B1); claims 1-7, 10-22, 27-28, and 30 under 35 U.S.C. §103(a) as unpatentable over Fijolek; and claims 8-9 and 29 under 35 U.S.C. §103(a) as unpatentable over Fijolek in view of Beser (U.S. Patent No. 6,212,563 B1).

Applicant respectfully disagrees with the Examiner's conclusions and believes that claims 1-32 are in condition for allowance. The following remarks are presented as support of this belief.

1. The Fijolek Reference

Fijolek is focused on managing network addresses in a data-over-cable system by granting timed leases on network addresses and efficiently managing the leases. Fijolek presents a description of how to create a network connection between customer premises equipment (CPE) and a data network that passes through a cable modem and a cable system.

However, Fijolek does not contemplate a situation where a connection to the data network is unavailable (a focus of the present invention). Likewise, Fijolek does not teach any response to a determination that a server is unavailable or to a determination that the server is back online. Additionally, Fijolek does not present a temporary configuration server that alters its response according to the availability of a configuration server

2. Response to the §102(e) rejections.

The Examiner rejected method claims 23-26 and 31-32 under §102(e) as being anticipated by Fijolek. These rejections are based upon inaccurate premises and should be withdrawn.

5 A. Claims 23-26

According to MPEP §2131, to anticipate a claim under 35 U.S.C. § 102(e), a single reference *must teach each and every element of the claim*. Because Fijolek does not teach every element of claim 23, it cannot properly be said to anticipate the claim.

Claim 23 provides a method that takes a specific action (sending a temporary network
10 address to the CPE) if a connection cannot be made with a configuration protocol server. However, the reference cited by the Examiner (Fijolek) *does not even contemplate* a situation where a configuration protocol server is unavailable (or cannot be connected).

The Examiner alleges that Fijolek teaches the step of *determining whether a connection can be made to a configuration protocol server*. For support of this allegation, the Examiner
15 points to a sentence in Fijolek that discusses obtaining a host interface address.¹ Simply obtaining a network address (as disclosed by Fijolek) not the same as determining whether a connection can be made (as claimed by Applicant).

In addition, Fijolek fails to teach that a temporary network address is sent *in response to the determination*. In fact, Fijolek gives no indication of how or when temporary network

¹ "CM 16 [Cable modem] must first *determine an address* of a host interface (e.g., an IP 54 interface) available on CMTS 12 that can be used by data network 28 to send data to CM 16." (Fijolek, col. 12, lines 17-20).

addresses are sent to CPE. Because Fijolek fails to disclose every element of Claim 23, it cannot properly be said to anticipate the claim or its dependents.

B. Claim 31

Independent claim 31 contains the same limitations described above. Thus, claim 31 and
5 its dependents should be allowed for the same reasons as claim 23.

In addition, claim 31 and its dependents provide that the network connection determines whether a connection can be made to the configuration protocol server, and if not, responding to the customer premises equipment by sending an acknowledge message. Because these elements are not seen in Fijolek, they cannot be said to be anticipated.

10 Specifically, Fijolek does not provide for 1) determining whether a connection can be made to the configuration protocol server; 2) taking a specific action in response to a determination that a connection cannot be made; or 3) sending an acknowledge message in response to a determination that the connection cannot be made.

These differences provide further evidence of the lack of anticipation.

C. Claims 26 and 32

15 It appears that the Examiner did not fully understand the limitations added by Claims 26 and 32. Applicant respectfully requests reconsideration of these claims and submits this further explanation.

The paragraphs cited by the Examiner in Fijolek refer to sending a decline message when
20 there are problems. In the present invention, however an NACK is sent only after the system is

running properly (i.e. when there are *not* problems). That is, a NACK is only sent once it is determined that a connection can be established with the configuration protocol server.

One purpose of the NACK is to allow a transition from a temporary address supplied by the cable modem (network connection) to a network address supplied by the configuration
5 protocol server.

Because Fijolek does not disclose the elements of claims 26 or 32, these claims cannot be anticipated by the reference.

3. Response to the §103(a) rejections.

The Examiner rejected claims 1-22, 27-30 under 35 U.S.C. §103(a) as either unpatentable
10 under Fijolek alone or unpatentable under Fijolek in view of Beser. The Applicant disagrees with this conclusion and, in the following paragraphs, provides support for the argument that Fijolek and Beser do not render the claims obvious.

A. Claims 1-22, 27-29

Claim 1 and the associated specification describe a communications system where an
15 improvement is a temporary configuration server (preferably operating within a cable modem 15a or network interconnection device 17). The temporary configuration server is configured to respond to configuration messages from customer premises equipment (CPE) that are received before a network connection 13 is able to connect the CPE to a data network 28.

The Examiner has mounted a §103(a) rejection of claim 1 as obvious based solely on
20 Fijolek despite the fact that “Fijolek explicitly fails to teach a temporary configuration server.”

(Office Action of December 4, 2003). It appears that the Examiner has latched upon Fijolek’s

one and only mention of a “temporary network address” to cobble together an argument. Specifically, Fijolek discloses that: “DHCP 66 allocates temporary or permanent network addresses (e.g. IP 54 address) to network host clients such as CM 16 or CPE 18.” (Fijolek, col. 28, lines 22-24). It is an inconceivable stretch that this lone mention of temporary network
5 addresses somehow renders claim 1 obvious.

First, the Examiner’s rejection is improper because it fails to show where a “temporary configuration server” that is configured to respond prior to a connection being available is taught or suggested in prior art. In fact, the Examiner does not even allege that the temporary configuration server would have been obvious.

10 Second, notwithstanding the lack of teaching a temporary configuration server as claimed, the Examiner has failed to show how Fijolek teaches or suggests the functional limitations of the improvement. For example, none of the passages cited by the Examiner provide any disclosure for *responding* to configuration messages from CPE.

15 Additionally, none of the passages provide any disclosure relevant to responding to messages “*before the network connection is capable of connecting the CPE to the data network.*” Fijolek’s teachings revolve around managing network addresses in a data-over-cable system and *do not discuss* operations when a connection to the data network is unavailable.

The Examiner has therefore failed to make a prima facie finding of obviousness as to claim 1 and its dependents. Independent claims 16 and 27-29 contain the same limitation of the
20 temporary configuration server (with the same functional limitations). Thus, claims 16, 27-29 and their dependents should also be allowable for the same reasons as claim 1.

B. Claim 30

Claim 30 depends from independent claim 29 and thus should be allowable for all the reasons that claim 29 is allowable.

The Examiner rejected claim 29 under §103(a) as unpatentable over Fijolek in view of Beser (U.S. Patent No. 6,212,563 B1). The Examiner then rejected dependent claim 30 under §103(a) as unpatentable over the single reference of Fijolek. It is quite irregular to reject an independent claim based on a combination of two references and reject the dependent based on only one of the references. Thus, Applicants respectfully request a reconsideration of this rejection.

4. Summary

Applicant respectfully submits that, in view of the remarks above, all claims are in condition for allowance and solicits action to that end. If there are any matters that can be resolved through a telephone interview, the Examiner is respectfully requested to contact Applicant's undersigned representative.

Respectfully submitted,

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